

## **REMARKS**

Claims 1-3, 5-16, and 18-22 are pending in the present application. Claims 1-3, 7-12, 14-16, 18, and 19 have been amended. Claims 4 and 7 have been cancelled. New claims 21 and 22 have been added. Applicant hereby requests entry of this Amendment and further consideration of the present application in view of the following remarks.

Independent claims 1, 9, and 12 have been amended to recite that the broadcast receiver is particularly a broadcast radio receiver, and the dependent claims have been correspondingly amended. New claims 21 and 22 are directed to an embodiment where a song is directly downloaded to the broadcast radio receiver. Support for this amendment is found throughout the specification, such as the broadcast radio receiver 14 shown in Fig. 1, and discussed in paras. [0018]-[0022]. Accordingly, no new matter has been added by the present amendment. As is more fully set forth below, the suggested combination of references does not render obvious any claim as amended herein.

### **Examiner's Response to Amendment dated July 21, 2008**

The Examiner noted Applicant's earlier Response to the Office Action mailed 3/17/2008, with such Response received on 7/21/2008. The Examiner acknowledged the amendments to claims 1, 9 and 12, found persuasive Applicant's arguments in the Response, and then stated the arguments are moot due to the new rejection necessitated by amendment. OA, p. 2. Applicant submits that the earlier arguments are not moot insofar as the same grounds of rejection are again asserted against the rejected claims in the present Office Action.

### **Rejections under 35 USC §112, ¶1**

Claims 1, 9 and 12 stand rejected under 35 U.S.C. §112, ¶1, as the Office Action contends that the specification, while being enabling for the product or services being downloaded, does not reasonably provide enablement for the download being made directly to the broadcast receiver. Insofar as this ground of rejection pertains to the claims as amended, Applicant traverses this rejection and requests reconsideration thereof.

Applicant notes that the Office Action firstly rejects this element of the “direct download to the broadcast receiver” as being non-enabled under Section 112, paragraph 1, but then cites the same feature as Applicants’ Admitted Prior Art (OA, p. 3) and used this admission in combination to reject the claims under 35 U.S.C. §103(a)(OA, pp. 5-6). Applicant has admitted that the direct download of purchased goods or services to a computer device is known in the prior art (See specification, para. [0020]), as the Office Action likewise notes. It is axiomatic that prior art applied under 35 U.S.C. §103(a) must be enabled. *In re Payne*, 606 F.2d 303, 314 (CCPA 1979) (“References relied upon to support a rejection under 35 USC §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public.”) Yet, references relied upon to reject the elements of a claimed invention are presumed to be operable. MPEP §2121.01. Consequently, there is an assumption that the download feature is operable and enabled as it is cited as a reference under Section 103, and as such, is contradictory to the rejection under Section 112 for non-enablement of the download feature.

Applicant agrees that the feature of the direct download of direct download of purchased goods or services to a computer device is known in the prior art, and the reference in Applicant’s specification to this specific element is accordingly operable and enabling. Therefore, this ground of rejection under 35 U.S.C. §112, ¶1, should be withdrawn.

#### **Rejections under 35 U.S.C. §103(a)**

Claim 1-13 and 15-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Kesling et al.* (US 200210132575 A1) in view of *Borovoy* (US 20030204446) or *Joseph* (US 5,819,034) and further in view of Applicant’s Admitted Prior Art (“APA”) (see Ewald US PG PUB 20050071240 specifically para 0020 lines 16-20). Insofar as this ground of rejection pertains to the claims as amended, Applicant traverses this rejection and requests reconsideration thereof.

Applicant firstly traverses the suggestion that the references are properly combinable in order to reject the present claims under 35 U.S.C. §103(a). It is noted that the Examiner sets forth as the reason for combining *Kesling*, *Borovoy* and *Joseph* at page 6 of the Office action based upon creating impulse sales. The Examiner is correct that a reason for combining the references is needed. As set forth in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007):

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

The claims as amended are directed to a radio broadcast receiver. Accordingly, the only radio receiver shown in the cited reference is in *Kesling*. The suggested combination accordingly must be a modification of *Kesling*. Here, the examiner's sole reasoning for the suggested combination is based upon "impulse buying" OA, p. 6. This suggested combination simply lacks factual support in the record.

*Kesling* involves a satellite radio broadcast system. *Borovoy* teaches an involved method and system for purchasing goods and services that requires the interaction of a first user and a first PDA and a second user and a second PDA. *Joseph* is for a distributed computer system for transmitting and receiving executable multimedia applications that allow purchases to coincide with a television show. The overall complexity of each these systems will mitigate against one of skill in the art combining them given the technological barriers—*Kesling* involves satellite radio and *Borovoy* and *Joseph* involve distributed computer systems. Moreover, the impetus addition of the APA to provide "instant access" to the download is only provided with the hindsight of the present disclosure. Therefore, Applicant respectfully requests that this ground of rejection be withdrawn in view of the improper combination of the references.

Turning to the rejection as it pertains to claims 1-13 and 15-20, Applicant will assume that the main ground of rejection is applied against independent claim 12 as the steps of the method therein appear to be primarily addressed in the Office Action. Applicant submits that the below arguments are likewise applicable to support the patentability of independent claims 1 and 9, the rejections of which are not independently addressed.

As previously argued by the Applicant, the user interface 1000 of *Kesling* “allows the receiver to receive input from a listener/user indicating an interest in a given selection.” *Kesling*, para. [0041]. The pressing of the button 1220 selects a “program identifier” and the user receives a “media link,” which can be a physical or wireless link to more information about the program. *Kesling*, paras. [0041], [0064], [0065]. In reviewing how a user “purchases” goods and services by way of the *Kesling* system it is seen that the user cannot simply press select button 1220 of the *Kesling* receiver and purchase the desired good or service. Rather, the “purchase” of a good or service by way of the *Kesling* system requires further interaction and action on the part of the user. The *Kesling* receiver does not record “purchase data” as required by claims that can be simply verified by the server(s) that receive the purchase data in order to complete the purchase.

The Examiner alleges that *Kesling* “teaches sending purchase related information back to the server using a one click method (para0065) but agrees that *Kesling* does not teach the limitation that the purchase is accomplishable without further interaction from the person. OA, p. 5. The Examiner alleges that either *Borovoy* cures the deficiency of *Kesling* that the purchase is accomplishable without further interaction from the person because *Borovoy* teaches the Amazon.com one-click method to send purchase data from a portable device to a website in a one click manner, citing paragraph [0017] of *Borovoy*, or alternatively, that while “*Kesling* teaches sending purchase related information back to the server using a one click method (para 0065), but does not specifically mention that the purchase is accomplishable without further interaction from the person [and] *Joseph* teaches initiating a transaction from a broadcast receiver (Col. 8, Lines 35-67).” OA p. 5. The suggested combination of elements from *Borovoy* and *Joseph* do not cure the deficiencies of *Kesling* in failing to teach or disclose all elements of the rejected claims.

The *Borovoy* teaching of using a one-click method to send purchase data from a portable device to a website in a one click manner must be read in the context of the entire reference, not in isolation as the Examiner has done. *In re Lancer*, 465 F.2d 896, 899, 175 USPQ 169, 171 (CCPA 1972) (“when ‘all of the disclosures in a reference’ are considered, the overall suggestion to emerge from the prior art reference may be contrary to that which might appear from an isolated portion of the reference.”). *Borovoy* teaches an involved method and system for purchasing goods and services that requires the interaction of a first user and a first PDA and a second user and a second PDA where the first user enters “enough data to uniquely identify a product or service to be purchased or otherwise obtained on the web. Then, when that customer or potential customer of Amazon or Yahoo wants to provide that information to another customer who has the necessary software on his PDA, she could beam it from her PDA to the other customer’s PDA.” *Borovoy*, para. [0015]. *Borovoy* also teaches that more than two PDAs may be used together. *Borovoy*, para. [0021]. In another embodiment, a PC may be used together with the second PDA. When the PDA synchs with the PC, the order may be placed using a command in the second PDA to connect to the appropriate website to place the order. *Borovoy*, para. [0022].

*Borovoy* teaches that the order software on the PDA may require at least one click from the recipient PDA before the order is placed, but that this feature, the one-click, is not necessary. *Borovoy*, para. [0025]. The Applicant contends that although the one-click from the recipient PDA is not necessary before the order is placed, a further interaction is required for the order to be completed. To explain, *Borovoy* teaches that the order will be “placed automatically either immediately upon receipt of the beam, if the PDA is already connected to the web, or upon connecting the PDA with the web, or automatically upon synching the PDA to a PC,” all requiring further interactions on the part of the user. Even in the embodiment where the order is placed immediately upon receipt of the beam by the second user, the purchase can only be completed if the second user initially takes the necessary actions to receive the beam on the second PDA from the first user’s first PDA. Those actions constitute further interaction from the second person.

In other words, the method and system of *Borovoy* are analogous to the flash media embodiment of *Kesling* where upon learning of goods and services that are desired to be purchased (in *Borovoy*, by way of the first user informing the second user of the goods and services), the user cannot purchase those goods and services without further interaction by the user, e.g., remove the flash media from the broadcast receiver and inserts the media into a reader. *Kesling*, [0041]. In *Borovoy*, the further interaction includes at the least the steps needed to receive the beamed information from the first PDA by the second PDA. In contrast, according to the method, receiver and system of the pending claims, the user upon first learning of the goods and services by way of the broadcast receiver can simply purchase the goods and services by submitting a purchase request without any further interaction required. Accordingly, the order of *Borovoy* cannot and does not occur without further interaction from the person placing the order as it will by the person using the Applicant's invention.

The PTO has determined that *Borovoy* does not enable automatic connection to the World Wide Web. It is also noted that in addition to *Borovoy* teaching the Amazon.com one-click method to send purchase data from a portable device to a website in a one click manner as stated by the Examiner in the Office Action, *Borovoy* also teaches an embodiment where "an order is placed automatically when the second user connects the second portable handheld PDA to the World Wide Web." See, e.g., *Borovoy*, paragraphs [0022] and [0025]. A review of the prosecution history of the *Borovoy* application on Public PAIR at [www.uspto.gov](http://www.uspto.gov), reveals that the application is abandoned for failure to respond to an Office action and no continuing applications are listed. Claim 25 of *Borovoy* reads:

25. (Previously presented) The method of claim 1 wherein the order is placed automatically when the second user connects the second portable handheld PDA to the World Wide Web.

The final rejection entered August 28, 2006, in *Borovoy* states:

Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 25, the recitation "the order is placed automatically when the second user connects the second portable handheld PDA to the World Wide Web" is abstract and does not enable one skilled in the art to determine how the order is placed automatically or what causes the order to be placed automatically. How is the specially formatted description, assuming it is used to place the order, used to place the order automatically?

Since *Borovoy* is non-enabled in regard to automatically connecting to the web, it cannot cure the deficiency of *Kesling* that the purchase is accomplishable without further interaction from the person. That *Borovoy* is non-enabled in terms of automatically connecting with the web is consistent with the position taken by Applicant in the previous appeal that *Kesling* did not enable the "purchase" described therein. Attention is drawn to the Declaration of Walter E. Thain, Jr. where Mr. Thain states his opinion based upon the facts set forth in the declaration that "pressing button 1220 does not enable a complete purchase transaction in the system described by *Kesling*...."

With regard to *Joseph*, it specifically discloses an "interactive TV system" where: "[w]hen a viewer wishes to order an item, a button is pressed on the TV remote control. This button signals the client computer 22 to display a series of instructions and menus necessary to solicit the information necessary to place the order, e.g. the item number, name and address of the viewer, the method of payment, the credit card number (if needed), etc." Col. 8, Lines 34-40.

*Joseph* does discuss the ability to order an item "by simply pressing one button on the TV remote control." Col. 8, Lines 63-64. However, the system in *Joseph* is integrated with the TV, i.e. a closed system, and does not make the purchase based upon information contained in the broadcast media.

The system in *Joseph* must, *a priori*, know what show is being shown on the television in order to effect the purchase. See e.g. Col. 9, Lines 3-5 (“the code and data modules related to the home shopping program are repetitively inserted into the data stream[ ]”). The “instant” purchase embodiment likewise states that knowledge of the “time codes” or “other commands” in the data stream is required by the client computer to “know which item is currently offered for sale.” Col. 8, Lines 63-64. This is not broadcast media, but a specialized media application, called an “auxiliary data stream” in *Joseph*. Col.6, Lines 34-36. (“In such an interactive TV system, for example, the auxiliary data includes the video and audio portions of the underlying television signal.”). This is in contrast with the broadcast music handled by *Kesling*, and consequently, it is not readily apparent how the system of *Joseph* would be used with a broadcast media “such as a radio signal” (*Ewald*, [0017]) where the *Joseph* system would have no advance knowledge of what is being broadcast. Accordingly, *Joseph* is not properly combinable with *Kesling* in the manner proposed.

In order form a proper rejection under Section 103, there must be some motivation to combine the references, and the references much teach or disclose all limitations of the rejected claims. MPEP §2143, et seq. No proper motivation to combine these four references has been shown, and the suggested combination ignores the teachings of *Joseph* and would not be used with a broadcast media stream. Therefore, this ground of rejection of claims 1-13 and 15-20 should be withdrawn.

Regarding the specific rejection of claim 3 in which the Office Action states that element of “the purchase data may be transmitted at a predetermined location,” Applicant cannot identify which reference is being cited to. Citation is only given to “(par. 0043)” with no further identification of a reference. Accordingly, Applicant must traverse this ground of rejection and cannot frame an adequate response thereto at this time until proper citation to a reference is given.

Regarding the specific rejection of claims 5 and 6 wherein the Office Action stated that “*Kesling* discloses that the broadcast media may be an advertisement (information about the purchase of a particular good or service) or a song (no information about the purchase of such song),” Applicant traverses this rejection insofar as it pertains to the claims as amended and hereby requests reconsideration thereof. Claims 5 and 6 are dependent upon independent

claim 1, and are therefore patentable for at least the reasons articulated above with respect to the patentability of the independent claims.

Regarding the specific rejection of claims 7 and 8, in which the Office Action stated “the broadcast receiver may comprise either a single device (par. 0041) or an ‘intermediate transfer device’ may be additionally employed as a purchase selection device (par. 0042),” specifically directing applicant to the *Kesling*, Applicant traverses this rejection insofar as it pertains to the claims as amended and hereby requests reconsideration thereof. Claims 7 and 8 are dependent upon independent claim 1, and are therefore patentable for at least the reasons articulated above with respect to the patentability of the independent claims

Regarding the specific rejection of claim 20, in which the Office Action stated that “the combination of *Kesling* and *Borovoy* teach where in the two devices are separate (*Kesling* 0042),” Applicant traverses this rejection insofar as it pertains to the claims as amended and hereby requests reconsideration thereof. Claim 20 is dependent upon independent claim 1, and is therefore patentable for at least the reasons articulated above with respect to the patentability of the independent claims.

Regarding the specific rejection of claim 14 as being unpatentable over *Kesling* in view of *Borovoy* or *Joseph* and further in view of Official Notice regarding secure communication channels, Applicant traverses this rejection insofar as it pertains to the claims as amended and hereby requests reconsideration thereof.

The Office Action states that while “*Kesling et al.* does not disclose a secure communication channel...it is notoriously well-known to employ secure communication channels when endeavoring to conduct transactions of the type disclosed by *Kesling*. One of ordinary skill in the art would have modified the *Kesling* method to have included sending purchase data via a secure channel in order that confidential information relative to the customer or the customer's account is not readily intercepted.” OA, p 7. Applicant traverses this modification of *Kesling* as there has been no showing that *Kesling* transmits or is properly modifiable to transmit customer data, and therefore, there is accordingly no motivation to secure such data. Otherwise, claim 14 is dependent upon independent claim 12, and is therefore patentable for at least the reasons articulated above with respect to the patentability of the independent claims.

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**PATENT**

Conclusion

In view of the foregoing remarks, Applicant respectfully submits that Claims 1-3, 5-16, and 18-22 are in condition for allowance and entry of the present amendment and notification to that effect is earnestly requested. If necessary, the Examiner is invited to telephone Applicant's attorney (206-332-1380) to facilitate prosecution of this application.

No additional fees are believed due. However, the Commissioner is hereby authorized to charge any additional fees that may be required, including any necessary extensions of time, which are hereby requested to Deposit Account No. 23377.

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